REMARKS

Claims 1, 3, 5 and 16-21 are pending in this application. By this Amendment, claims 7, 9, 11 and 13 are canceled without prejudice to, or disclaimer of, the subject matter recited therein. No new matter is added. Reconsideration and prompt allowance of the application are respectfully requested.

Entry of the amendments is proper under 37 CFR §1.116 because the amendments: (a) place the application in condition for allowance for the reasons discussed herein; (b) do not raise any new issue requiring further search and/or consideration (as the amendments amplify issues previously discussed throughout prosecution; and (c) place the application in better form for appeal, should an appeal be necessary. The amendments are necessary and were not earlier presented because they are made in response to arguments raised in the final rejection. Entry of the amendments is thus respectfully requested.

I.   The Claims Define Allowable Subject Matter

The Office Action rejects:

1.   claims 1 and 16-19 under 35 U.S.C. §103(a) as being unpatentable over Ostrover et al. (U.S. Patent No. 6,585,154) in view of Doi (U.S. Patent No. 5,995,712) and further in view of Teraura (U.S. Patent Application Publication No. 2002/0170973);

2.   claim 3 under 35 U.S.C. §103(a) as being patentable over Doi in view of Teraura; and

3.   claims 5, 7, 9, 11, 13, 20 and 21 under 35 U.S.C. §103(a) as being unpatentable over Doi in view of Teraura and further in view of Ostrover.

The rejections are respectfully traversed.

Independent claims 1, 3, 16 and 17 recite at least a first and second image forming member. The Office Action asserts that Ostrover teaches substantially all of the currently

claimed combination of features including "a second image forming member being different from the first image member." For support, the Office Action cites to writing surface 70 of Ostrover and the quotation at col. 5, lines 45-50 wherein Ostrover states that "the term printer refers to any device which produces a legible copy of a data on a writing surface." However, col. 6, lines 21-23 state that a memory device of a microchip 22 includes a mechanism for affixation 68 to document 42 or a writing surface 70. Fig. 1 to which this passage refers depicts only a "surface 72." Moreover, the quoted passage refers to a document 42 or a writing surface 70.

Accordingly, the stated writing surface is either alternative to the document 42, or document 42 is merely an example of the writing surface. Applicants respectfully submit that there is no suggestion whatsoever, much less an enabling teaching of both a first image forming member and a second image forming member in one device or system or to be used in a method. Applicants therefore respectfully request withdrawal of the first and third rejections on at least this basis.

Each of rejections 1-3 listed above rely on at least Doi in combination with one or more of the applied references. Specifically, the Office Action asserts that Doi teaches Applicants' claimed "data writing unit," "selecting unit," and "data reading unit." Applicant respectfully disagrees.

Specifically, Applicants respectfully submit that Doi fails at least to teach the claimed data writing unit. The Office Action asserts that the image I/O unit 41 corresponds to the currently claimed data writing unit. Moreover, the Office Action explains that the image I/O unit 41 writes the image data from the image read device 2 to the frame memory 42. Col. 6, lines 18-24 state that the "image I/O unit 41 then transfers the image data stored in the frame memory 41 to the image form device 3, and the image form device 3 then forms an image on a recording paper sheet according to the image data from the memory device 4."

However, col. 2 of Doi makes clear that the memory device 4 is included in the digital copier itself. Thus, the alleged data writing unit of Doi writes not to the data storage unit located on an image forming member, but instead writes to memory in the printing apparatus itself.

Contrarily, the claimed data writing unit writes into the data storage unit the first image forming member "plural pieces of image data" that correspond to images read by the image reading unit. Thus, the alleged data writing unit of Doi cannot possibly correspond to the data writing unit presently claimed.

Further, Teraura fails to remedy this deficiency in Doi because Teraura discloses at paragraph [0010] only a "recording means for recording said RFID data in said RFID tag." The Office Action also cites to paragraph [0093] wherein Teraura merely discloses that the disclosed control circuit 29 controls the third reader/writer 17 to write the data read from the RFID tag 14 of the sheet of document paper 61 in the RFID tag 14 of the sheet of printing paper 13 in step B17. "Next, the control circuit 29 controls the printing unit 11 to print the image including characters, figures, and photo images read from the sheet of document paper 61 with the RFID tag 14 on the sheet of the printing paper 13 with the RFID tag 14 in step B18, and processing ends." While Teraura discloses in this paragraph that data is transferred from one RFID tag to another, this paragraph fails to indicate whatsoever what type of data is transferred.

In fact, a logical reading of this paragraph indicates that the read image data is merely used to "print the image including characters, figures, and photo images." A reading of paragraph [0092], the immediately preceding paragraph, makes clear that the data read from RFID tag 14 of the sheet of document paper 61 includes an ID number, and it is this ID number that is transferred into RFID tag 14 of the sheet of the printing paper 13 in step B14. Paragraph [0092] states that "next, the control circuit 29 controls the printing unit 11 to print

the image including characters, figures, photo images read from the sheet of document paper 61 with the RFID tag in step B15. In the following step B16, the control circuit 29 stores the ID number of the operator in the RFID tag 14 of the sheet of document paper 61, and processing ends. In this step, time stamp data from the timer circuit 54 may be stored in the RFID tag 14 also."

Thus, a reasonable reading of paragraphs [0092] and [0093] reveals that data may be read from a first RFID tag 14, but that subsequently image data is merely used to print an image, while ID number data or time stamp data is the type of data that may be stored in the RFID tag of the printing paper 13. Thus, Teraura fails to remedy the deficieny in Doi because Teraura fails at least to disclose a data writing unit that writes "plural pieces of image data, which indicate the image is read by the image reading unit," much less a data writing unit that "writes into the data storage unit of the first image forming member."

Indeed, Teraura is no different than Doi in that any image data read by the disclosed reader/writer unit is written at best to a data storage unit enclosed in the printer copy machine itself, rather than writing image data to an RFID tag 14. Accordingly, Applicants respectfully submit that Doi and Teraura fail to disclose at least the claimed data writing unit.

With regard to the claimed "selecting unit," the Office Action asserts that Doi inherently discloses a selecting unit because an operator selects the combined copy mode by the memory copy key and inputs a number of image data to be combined. The image read device 2 reads the first original document image with a reproduction operation according to the number of images to be combined. The image data from the image data device is then sent to the memory device 4. The Office Action asserts that the Examiner believes that when all of the original documents are scanned and stored, they will be set to combine according to the operator selection. Thus, the combination is performed by selecting the read documents by the read device now stored in the memory.

-10-

However, Applicants respectfully submit that the Office Action misunderstands the claimed "selecting unit." Specifically, the claims recite a "selecting unit" that receives an operation to select at least one of the plural pieces of image data read by the data reading unit and written to the data storage unit of the first image forming member by the data writing unit. In this manner, one may choose certain images of a combined image formed on the image forming member to be printed. Thus, the claims contemplate a process of forming a combined image, and then from the formed combined image selecting one or more images among the combined images for further processing.

Contrarily, Doi may be arguably considered to disclose at best only the initial combined process. Thus, Doi cannot possibly be considered to teach or render obvious the selecting unit which selects at least one of the plural pieces of image data corresponding to images comprising the combined image. Doi fails to disclose whatsoever any processing of the resulting combined image. Thus, Applicants respectfully submit that Doi fails to teach the claimed "selecting unit," and the applied references fail to remedy this deficiency.

With regard to the claimed "data reading unit," the Office Action asserts that Doi discloses "the selecting unit receives an operation to select at least one of the plural pieces of image data read by the data reading unit." However, the Office Action admits that "Ostrover and Doi do not explicitly teach ... a data reading unit reads the plural pieces of image data, which indicate the respective images and are supplied from a data supply unit of the first image forming member." Applicants respectfully submit that this alleged factual finding is unfounded in view of the Office Action's clear statement that Doi fails to disclose the "data reading unit." Specifically, the very claim recitation that the Office Action asserts Doi teaches directly refers to the claimed "data reading unit." For example, claim 1 recites in part "the selecting unit receives an operation to select at least one of the plural pieces of image data read by the <u>data reading unit</u>."

Further, Fig. 11 of Doi shows a flowchart of a process of a combined copy by a copier application. In step S4, the combined copy process is executed. Fig. 12 shows a flowchart of the combined copy process, which is described at col. 7, lines 12-13. In Figs. 11 and 12 (as described at col. 6, line 36 - col. 7, line 52), Doi fails to teach that "an operator selects at least one of the plural pieces of image data read by the data reading unit." In Doi, an operator may select at least one of the plural original documents as an original document to be subject to the combined copy process as a whole. However, the operator's action is selecting an original document. This is completely different than "selecting at least one of the plural pieces of image data read by the data reading unit." The claimed plural pieces of image data may themselves comprise a whole document. At best, a user of Doi's method may select only a whole document, i.e., a whole image. The user may not select pieces of the image, and thus Doi cannot be considered to disclose a "selecting unit [that] receives an operation to select at least one of the plural pieces of image data read by the data reading unit" because Doi has no use for such structure. Thus, Applicants respectfully submit that Doi fails to teach, and would not have rendered obvious alone or in combination with either of the applied references, the claimed selecting unit as recited in independent claims 1, 3, 16 and 17.
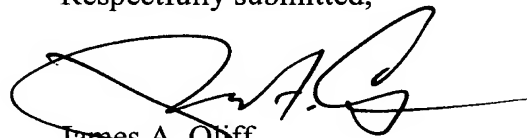
In view of the foregoing, Applicants respectfully submit that the applied references would not have rendered obvious the currently claimed combination of features of claims 1, 3, 16 and 17, and claims depending therefrom. Accordingly, withdrawal of the rejections 1-3 is respectfully requested.

II. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of the claims are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,

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JAO:RAC/amt

Attachment:
    Petition for Extension of Time

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